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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,860	09/27/2001	Masataka Masuda	P07340US00/	5469

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EXAMINER

NGUYEN, TAM M

ART UNIT	PAPER NUMBER
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1764

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/913,860

Applicant(s)

MASUDA ET AL.

Examiner

Tam M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 27, 2006 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-06-228570 in view of Masuda et al. (6,042,798) and Logsdon et al. (4,876,402).

The JP patent discloses a desulfurization process by contacting a raw hydrocarbon feed comprising methane, ethane, propane, and butane with a catalyst comprising Cu, Zn, and Ni oxide, in the presence of hydrogen. (See paragraphs 0016-0029). When the raw hydrocarbon is a town, the desulfurization step is operated at a pressure of from 1 - 10 kg/cm² (1 - 10 atm) and at a temperature of from 280-380° C and the molar ratio of hydrogen to town gas is 0.36. (See paragraphs 25, 41, 0025, 0029, and 0030)

The JP patent does not disclose that the desulfurization step is operated at a space velocity (GHSV) of 200 to 10,000 h⁻¹. However, Masuda discloses a hydrodesulfurization process wherein the process is operated at a space velocity (GHSV) of about 1,000 h⁻¹ (See examples). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of the JP patent by operating the desulfurization step at a space velocity as taught by the Masuda because such space velocity is known to be effective in a desulfurization process.

The JP patent does not disclose that the desulfurization is formed so that the sulfur content in the town gas is not more than 6 ppb. However, the modified process of the JP patent is similar to the claimed process in terms of feedstock, operating conditions, and catalyst.

Therefore, it would be expected that the modified desulfurization process of the JP patent would have the sulfur content in the town gas as claimed.

The JP patent does not disclose a step of making the catalyst as claimed.

Both Masuda and Logsdon disclose a process of making a catalyst as claimed.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of the JP patent by making the catalyst as taught by either Masuda or Logsdon because such method is effective way to produce catalyst.

Response to Arguments

The present method does not relate to a catalyst for promoting a chemical reaction and a method of making a catalyst and a desulfurizing agent is not a catalyst because the present desulfurizing agent absorbs sulfur compound itself, resulting in chemical change in the composition of the agent is not persuasive. The limitation “desulfurizing agent” would encompass anything that results in desulfurizing including a desulfurized catalyst. The present claimed process does not claim that “the desulfurizing agent adsorbs sulfur compounds resulting in chemical change in the composition of the agent.”

The argument that a method for producing a catalyst for hydrogenation of aldehyde is totally unrelated to the desulfurization method and nowhere in the cited references disclosed as to how one would use a catalyst in a desulfurization method is not persuasive. The claimed method of the making a catalyst is known in the art (taught by both Masuda and Logsdon). One of skill in the art would produce the catalyst of JP reference by any method including the method that taught by the prior art. How a catalyst to be used is not related with how it is made. For

example, the catalyst of the JP reference can be used in any hydrogenation process such as hydrogenation of aldehyde, nitrogen, or olefins. It is reminded that the desulfurization of the JP reference is a **hydrogenation** process.

The argument that the present invention solves the problem of a large amount of heat generation is not persuasive because the modified process of the JP reference is the same as the claimed process. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

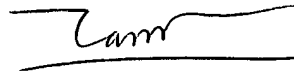
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (571) 272-1452. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tam M. Nguyen
Examiner
Art Unit 1764

TN

A handwritten signature in dark ink, appearing to read 'Tam', is written over a horizontal line.